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Merck & Co., Inc.
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Patent Department

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MISC. FEE TRANSMITTAL		<i>Complete if Known</i>	
		Application Number	10/556,932
<i>Patent fees are subject to annual revision.</i>		Filing Date	November 16, 2005
		First Named Inventor	Minoru, et al
		Examiner Name	Deepak R. Rao
		Group Art Unit	1624
		Attorney Docket Number	BY0025P
TOTAL AMOUNT OF PAYMENT	\$200		

METHOD OF PAYMENT	
<input checked="" type="checkbox"/> Deposit Account	
Deposit Account Number	13-2755
Deposit Account Name	Merck & Co., Inc.
The Director is authorized to:	
<input checked="" type="checkbox"/> Charge fee(s) indicated below	
<input checked="" type="checkbox"/> Credit any overpayments	
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	

FEE CALCULATION			
FEES Large Entity			
Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	Surcharge - late filing fee or oath	
1053	130	Non-English Specification	
1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1402	540	Filing a brief in support of an appeal	
1452	540	Petition to revive - unavoidable	
1453	1,620	Petition to revive - unintentional	
1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	Submission of Information Disclosure Statement	
1809	810	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	810	For each additional invention to be examined (37 CFR 1.129(b))	
1814	140	Statutory Terminal Disclaimer under 37 CFR 1.321	
Other fee (specify)		Filing for patent term adjustment under 1.18(e)	200
Other fee (specify)			
TOTAL			\$200

SUBMITTED BY				Complete (if applicable)	
Typed or Printed Name	Catherine D. Fitch			Reg. Number	36,502
Signature		Date	03/02/2009	Deposit Account User ID	

MAR 02 2009

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

.....
Applicants: MINORU *et al.*
Serial No.: 10/556,932 **Case No.:** BY0025P **Art Unit:** 1624
Filed: 11/16/2005 **Examiner:** Rao, Deepak R.
Entitled: 2-AMINOQUINOLINE DERIVATIVES
.....

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT,
UNDER 37 C.F.R. § 1.705

Dear Sir:

Applicants of the above-referenced patent request reconsideration of the patent term adjustment (PTA) indicated in the patent under 37 C.F.R. § 1.705. This application is being filed within two months of the February 3, 2009, issuance of the patent. On the face of the patent, the PTA is 529 days. Applicants believe that the patent should be awarded 604 days.

Statement of Facts:

1. The captioned patent application is a U.S. National Phase application filed under 35 U.S.C. § 371. The U.S. National Phase filing date is November 16, 2005.

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Case No. BY0025P
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2. The Patent Office issued a Non-Final Rejection on June 24, 2008, 951 days after the filing date. The 14-month cut-off for purposes of calculating delay under 37 C.F.R. § 1.703(a)(1) is January 16, 2007. The calculation of delay as 525 days is correct for this initial period.
3. A response to the Non-Final Rejection, dated June 24, 2008, was filed July 14, 2008.
4. The Patent Office issued a Notice of Allowance November 18, 2008, four days after the four-month cut off for purposes of calculating delay. The calculation of delay of 4 days is correct.
5. The Issue Fee was received at the Patent Office December 15, 2008.
6. The application granted as U.S. Patent No. 7,485,647, February 3, 2009. This is 77 days beyond November 16, 2008, the three year anniversary of filing the present application.
7. November 17, 2008, and November 18, 2008, are within both the 77 day delay from the 3 year anniversary of filing the application, and within the 4 day delay beyond the 4 month deadline for issuing the Notice of Allowance.
8. The present application for reconsideration of the PTA is filed within two months of the February 3, 2009, issuance of the patent.
9. This patent is not subject to a terminal disclaimer.
10. There were no instances in which Applicants failed to respond to an Official Action within the prescribed time frame. Consequently, a fee as set forth in 37 C.F.R. § 1.18(f) and a showing of the use of "all due" care under 37 C.F.R. § 1.705(c)(2) are not required.

Arguments in Support of Petition

Applicants request that the PTA determination be corrected to include the days accrued pursuant to 37 C.F.R. § 1.702(b). The Patent Office delay under § 1.702(b) is occurring more than

three years after the application was filed and overlaps 2 days of the 529 days due to delay under 37 C.F.R. § 1.702(a).

According to 37 C.F.R. § 1.702(a)(1), the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to mail at least one of a Notification under 35 U.S.C. § 132 or a Notice of Allowance under 35 U.S.C. § 151 not later than fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. § 371 in an international application. The requirements under section 371 for this international application were fulfilled on November 16, 2005. The date fourteen months after the section 371 requirements were fulfilled is January 16, 2007. A first Non-Final Office Action was mailed on June 24, 2008, which constitutes 525 days of Patent Office Delay under 37 C.F.R. § 1.702(a); i.e., the number of days from January 16, 2007 to June 24, 2008. A response to the Non-Final Rejection was mailed July 14, 2008, and the Patent Office issued a Notice of Allowance November 18, 2008, four days after the four-month cut off for purposes of calculating delay under 37 C.F.R. § 1.702(a)(2).

There were no circumstances constituting a failure of Applicants to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704. Accordingly, the PTA accrued under 37 C.F.R. § 1.702(a)(1)-(2), is Patent Office Delay-Applicant Delay = 525 - 0 = 525 days.

According to 37 C.F.R. § 1.702(b), the term of the original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the national stage commenced under 35 U.S.C. § 371. The date three years after commencements of the national stage is November 16, 2008. Under 37 C.F.R. § 1.702(b), 77 days have accrued.

The PTA determination of the Patent Office lists 529 days of Patent Office delay and 0 days of Applicant delay. The Patent Office PTA determination does not include the delay due to the failure to issue the patent within three years of the commencement of the national stage. Under *Wyeth v. Dudas*, No. 07-1492 (D.D.C. 2008), a patentee is entitled to both any "(a) period" delay under § 1.702(a), and any "(b) period" delay under § 1.702(b). According to *Wyeth*, 35 U.S.C. § 154 establishes that a patent term is 20 years from the earliest relevant filing date of a patent application. Because patentees do not benefit from patent term during prosecution, § 154(b)(1)

further provides a PTA to account for Patent Office delays under certain circumstances. For example, the statute provides a one-day extension of term for every day corresponding to an "(a) delay," that is, where the Patent Office fails to meet particular deadlines such as issuing a first Office Action within 14 months, responding to a reply within four months, and so forth. In addition, the statute addresses a "(b) delay" by giving a one-day extension of term for every day of prosecution that occurs three years after the filing date.

To prevent double-counting, 35 U.S.C. § 154 dictates that, to the extent that "(a) delay" and a "(b) delay" overlap, the PTA "shall not exceed the actual number of days the issuance of the patent was delayed." § 154(b)(2)(A). The Patent Office has interpreted this language to mean that a patentee may obtain credit for an "(a) delay" or a "(b) delay," whichever is longer, but not (a) + (b). According to the Patent Office prior to *Wyeth*, any period of "(b) delay" necessarily overlaps with any periods of "(a) delays." The District Court on *Wyeth* held that for purposes of determining PTA, the "only way those periods of time can 'overlap' is if they occur on the same day."

Applying *Wyeth* to the present situation, there are two days of overlap, specifically November 17, 2008, and November 18, 2008. Accordingly, Applicants are entitled to 529 days "(a) delay" + 77 days "(b) delay" – 2 days "actual overlap" = 604 days PTA.

Applicants believe this Request for Consideration is timely filed since the "(b) delay" could not have been calculated prior to the payment of the issue fee and issuance of the patent. The above-referenced patent is not subject to a terminal disclaimer.

Conclusion:

Applicants respectfully submit that the correct PTA is 604 days, which includes the full period of time calculated from the date that is three year after the filing date, i.e., November 16, 2005, until the patent is granted, less any actual days of overlap (two days), plus any additional time spent by the Patent Office in granted the patent, calculated from the date that is four months after payment of the issue fee.

Enclosed herewith is an authorization to charge deposit account 13-2755 the \$200.00 fee required under § 1.18(e).

CONDITIONAL PETITION

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Applicants hereby make a Conditional Petition for any relief available to correct any defect in connection with this filing, or any defect remaining in this application after this filing. The Commissioner is authorized to charge deposit account 13-2755 for the petition fee and any other fee(s) required to effect this Conditional Petition.

Respectfully submitted,

By 
Catherine D. Fitch
No. 36,502
Attorney for Applicants

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Date: March 2, 2009

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